

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/736,272	§	Examiner:	Peikari, Behzad
Filed:	December 15, 2003	§	Group/Art Unit:	2189
Inventor:		§	Atty. Dkt. No:	5760-16500
Ernest Patrick Hanavan III		§		
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Title:	Server-Free Archival of	§		
	Backup Data	§		
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PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as a petition under 37 CFR 1.144 from the restriction requirement made final in the Office Action dated March 8, 2007.

In the Office Action dated November 30, 2006, the Examiner presented a restriction requirement requiring election of one of the following two inventions as defined by the Examiner:

- I. Claims 1-6 and 18-19, drawn to basic backup and archiving in a storage area network, classified in class 711, subclass 162.
- II. Claims 7-17, drawn to backup and archiving in a storage area network, including “freezing” a memory to create a snapshot of data and subsequently “thawing” the memory, classified in class 714, subclass 15.

In response to the restriction requirement, Applicants elected invention I with traverse. The Examiner subsequently made the restriction requirement final. Applicants petition for withdrawal of the restriction requirement on the ground that the Examiner has not stated a proper restriction requirement for numerous reasons.

First, the Examiner incorrectly contends that Inventions I and II are “related as subcombinations disclosed as usable together in a single combination.” Invention I and II are not *disclosed as subcombinations* usable together in a single combination. For example, embodiments of the method of claim 7 (Invention II) can be carried out on embodiments of the systems of claims 1 and 18 (Invention II). Similarly, the functionality performed by the program instructions of claim 13 (Invention II) can be carried out on embodiments of the systems of claims 1 and 18 (Invention II). Note that according to MPEP 806.05(d), subcombinations are two separate components of a combination. In other words, subcombinations usable together in a single combination are two non-overlapping components of a larger combination. For example, a claim to a seat bracket and a claim to a gear mechanism could be two separate subcombinations usable together in a bicycle combination. In the present application, claim 1 is directed to a storage area network and claim 7 is directed to a method. Claims 1 and 7 clearly do not have the relationship of subcombinations usable together in a single combination under MPEP 806.05(d). Although claims 1 and 18 may vary in scope from claims 7 and 13, the Examiner has clearly mischaracterized Applicants’ claims as being directed to separate subcombinations usable together in a single combination. Thus, the restriction requirement is improper.

Furthermore, a proper restriction requirement for subcombinations disclosed as usable together in a single combination requires that the subcombinations “do not overlap in scope”, i.e., that the subcombinations are “mutually exclusive.” See M.P.E.P. 806.05(d) and M.P.E.P. 806.05(j).” There is clearly overlap in scope between the claims of group I and the claims of group II. Applicants are by no means asserting that the scope of the claims of group I is identical to the scope of the claims of group II. In fact, there are clearly differences in scope between the claims.

However, some of the claims of group I do have some overlap in scope with some of the claims of group II. For example, For example, from even the most cursory glance, it is readily apparent that claim 1 (group I) recites a system that is configured to perform at least some of the functionality that is claimed in the method of claim 7 (group II). Since, claims of group I have some overlap in scope with claims of group II, restriction cannot be required under M.P.E.P. 806.05(d). Therefore, the Examiner's restriction requirement is improper.

In the Office Action of March 8, 2007, the Examiner challenges Applicants "to provide an example of at least two claims that are subcombinations usable together that have not overlap in scope whatsoever. Applicants have already done so above. A claim to just the seat bracket and a claim to just the gear mechanism in the bicycle example above satisfies the Examiner's challenge. The examiner asserts that inventions with no overlap in scope are "independent" inventions. However, just because two subcombination do not overlap does not make them "independent" inventions if they are related as usable together in the same combination.

Moreover, the Examiner has not properly shown, by way of example, that any of the subcombinations has utility other than in the disclosed combination. According to M.P.E.P. 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, M.P.E.P. 806.05(d) also states that "the burden is on the Examiner" to make this showing. The example given by the Examiner is that "subcombination I has separate utility such as use without the need to freeze the memory – i.e. uninterrupted use of the memory." However, the Examiner is merely pointing out differences in limitation between the claims. While the independent claims of group I do not specifically recite the freezing of backup data, neither do they preclude such freezing. If any different in limitation between independent claims signaled a separate utility, the entire separate utility requirement becomes meaningless. Moreover, all of the independent claims in both groups can cover embodiments as described in Applicants'

disclosure that may freeze backup data. Thus, the Examiner clearly has not shown a separate utility for one of the subcombinations other than in the disclosed combination. Moreover, the separate utility requirement is in regard to a utility “other than in the disclosed combination.” Instead of providing an example of a utility other than in the disclosed combination, the example has merely focused on a difference in limitations between the different claim groups.

The requirement for a separate utility requires more than just noting a difference in limitations in the claims. According to M.P.E.P. 806.05(d), “[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” (emphasis added). The Examiner appears to have misunderstood the requirement for a subcombination to have utility *other than in the disclosed combination*. The Examiner merely points to differences between the claims. However, **by definition**, true subcombinations will always have different utility *with respect to one another* by their very nature of being separate and distinct non-overlapping components of a larger system (combination). The requirement of M.P.E.P. 806.05(d) is that a subcombination have a utility other than in the disclosed combination, not with respect to other subcombinations. All the examples given by the Examiner clearly apply to the same overall combination(s) as disclosed in the specification. Therefore, the Examiner has not stated a proper restriction requirement.

Another shortcoming of the Examiner’s restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. On page 3 of the Office Action, the Examiner states, “there would be a serious burden on the examiner if restriction is not required because the invention have acquired a separate status in the art in view of their different classification.” However, the Examiner’s reliance of a different classification to show a separate status in the art is misplaced because the purported classifications are clearly in accurate and not separate for the two claim groups. The Examiner classified claims 1-6 and 18-19 (Invention I) in class 711,

subclass 162 and claims 7-17 in class 714, subclass 15. However, these classifications could both be applied to all of the claims, and are thus not separate for the two groups.

According to the Manual of Classification, the definition of class 711, subclass 162 is for archiving and backup where a verbatim, redundant copy of the data is made. However, the claims of both inventions clearly recite making backup copies of data. Thus, class 711, subclass 162 applies to both inventions identified by the Examiner. The Definition for class 714, subclass 15 is for means or steps for recovery by restoring data in a data file, data for a process, to data at a previous point in time within a system for responding to a failure. However, this definition clearly applies to all the claims. Neither the claims of group I nor the claims of group II require “restoring data to a previous point in time with a system for responding to a failure”. Nor do they exclude such restoration of data. Thus, class 714, subclass 15 is not a truly separate classification for the claims of groups I and II.

As shown above, under an accurate classification, the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications are not very accurate and actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to establish “a serious burden on the examiner if restriction is not required.” *See* M.P.E.P. § 808.

The Examiner also states, “there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search.” The Examiner does not provide any statement as to why the two groups of claims require a different field of search. According to M.P.E.P. § 808.02(d), a different field of search is shown, “[w]here it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s).” The Examiner has not provided any reasoning to show why a search for claims 1-6 and 18-19 (Invention I) would not be likely to result in finding art pertinent to claims 7-17 (Invention II). As shown above, both of the classifications identified by the Examiner apply to all of the claims. Therefore, a search under either of the Examiner’s classifications would be

equally likely to find art pertinent to all of the claims. The Examiner clearly has not established that different fields of search would be required.

Since the Examiner's has failed to establish a "serious burden on the examiner if restriction is not required", Applicants' assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner's restriction requirement must be withdrawn.

In summary, the Examiner's restriction requirement is flawed for at least the following reasons: i) the Examiner has incorrectly characterized the claims as being limited to subcombinations disclosed as usable together in a single combination; ii) the Examiner has not shown a *separate* utility for either of the alleged subcombinations *outside of the disclosed combination*; and iii) the Examiner has failed to establish a valid reason why there would be a serious burden on the examiner if restriction is not required. Thus, a *prima facie* requirement for restriction has not been stated and the restriction requirement is improper. Accordingly, withdrawal of the requirement for restriction is respectfully requested.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5760-16500/RCK.

Respectfully submitted,

/Robert C. Kowert/

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